

REMARKS

As a preliminary matter, the Examiner has rejected Claims 41 and 44-46 under 35 U.S.C. § 112, second paragraph, as being indefinite. More specifically, the Examiner asserts that certain language in Claims 41 and 45 renders them unclear, and that certain terms in Claims 44 and 46 lack antecedent basis. Claims 41 and 44-46 have been currently amended to address Examiner's concerns. Accordingly, Applicant respectfully asserts that Claims 41 and 44-46 are now in acceptable form. Therefore, Applicant respectfully requests Examiner withdraw the rejection of Claims 41 and 44-46 under 35 U.S.C. § 112, second paragraph, as being indefinite.

The Examiner has rejected Claims 41-43 and 45 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,961,758 to Honegger ("Honegger"). The Examiner has also rejected Claims 41-46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,749,567 to DeAngelis ("DeAngelis"). In addition, the Examiner has rejected Claims 41-43, 46, and 47 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,678,813 to Osako et al. ("Osako").

The Examiner has also rejected Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Osako in view of U.S. Patent No. 5,662,448 to Graushar et al. ("Graushar"). In addition, the Examiner has also rejected Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 3,816,866 to Miaskoff et al. ("Miaskoff").

Claims 27-50 stand currently amended, with Claims 26-40 being withdrawn. Claims 1-25 stand previously canceled. Claims 26-50 are currently pending, with Claims 41-50 being currently rejected. The following remarks are considered by applicant to overcome each of the Examiner's outstanding rejections to current Claims 41-50. An early Notice of Allowance is therefore requested.

I. SUMMARY OF RELEVANT LAW

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. The determination of obviousness rests on whether the claimed invention as a whole would have been obvious to a person of ordinary skill in the art at the time the invention was made. In determining obviousness, four factors should be weighed: (1) the scope and content of the prior art, (2) the differences between the art and the claims at issue, (3) the level of ordinary skill in the art, and (4) whatever objective evidence may be present. Obviousness may not be established using hindsight or in view of the teachings or suggestions of the inventor. The Examiner carries the burden under 35 U.S.C. § 103 to establish a prima facie case of obviousness and must show that the references relied on teach or suggest all of the limitations of the claims.

II. REJECTION OF CLAIMS 41-43 AND 45 UNDER 35 U.S.C. § 102(B) BASED ON HONEGGER

On page 3 of the current Office Action, the Examiner rejects Claims 41-43 and 45 under 35 U.S.C. § 102(b) as being anticipated by Honegger. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Amended Claim 41 states, in part:

“a joining device for joining a cover sheet to at least one contents sheet;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

As an initial matter, Applicant notes that Claim 41 has been amended to specify that the folding device passes through the guide planes. This further clarifies what is meant by

"the two guide planes being provided in the vicinity of the folding device". Applicant respectfully asserts that Honegger fails to disclose this language of Claim 41.

Examiner asserts that Honegger discloses the remaining language of Claim 41 above. This, however, misinterprets the teachings of Honegger.

First, Honegger teaches to paper webs P.2 to P. 7, and not to sheets as stated in Claim 41. See Honegger, Col. 3, Lns. 17-18, Fig. 3. While the webs P.2 to P.7 are eventually cut so as to create sheets, this is not until after portions of the webs P.2 to P.7 are joined as a paper stack PSS. Honegger, Col. 3, Lns. 17-18 and 33-41, Fig. 3. As such, Honegger fails to disclose a joining device for joining a cover sheet to at least one contents sheet, as stated in Claim 41. Similarly, Honegger also fails to disclose separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively, as stated in Claim 41.

Second, Honegger teaches that the paper stack PSS is joined by the pair of pressing rolls 30. Honegger, Col 3, Lns. 36-39, Fig. 3. Only after the paper stack PSS is joined, is the paper stack PSS then cut by a cutting apparatus 17, and finally folded along the injection line J. Honegger, Col 3, Lns. 39-41, Fig. 3. As such, it is clear that any folding device (which Honegger fails to actually disclose) of Honegger is separate from the pair of pressing rolls 30 (i.e., joining device). Thus, Honegger fails to disclose a folding device being simultaneously a joining device so that the sheets can be joined during folding, as stated in Claim 41.

Examiner asserts that the folding device can also function as a joining device because the step of folding necessarily requires that sheets be pressed against each other at the area where the sheets are joined. However, this logic is flawed. If such were the case, then the pair of pressing rolls 30 would not be necessary. See Honegger, Col 3, Lns. 36-39, Fig. 3. However, as taught by Honegger, the pair of pressing rolls 30 are necessary in order to join the paper stack PSS, before the paper stack PSS can be folded. Honegger, Col 3, Lns. 36-41, Fig. 3. Thus, the paper stack PSS is already joined by the time it is cut by a cutting apparatus 17, and finally folded along the injection line J. Therefore, in fact, any folding device of Honegger does not join the paper stack PSS, and thus does not function as a joining device.

Third, Honegger fails to disclose a joining device. Examiner asserts that the disclosure of a folding step implicitly (i.e., inherently) requires a folding device after cutting apparatus 17. This, however, is not necessarily the case. In fact, Honegger is completely silent as to whether the cut brochures are folded by a device or by hand.

The MPEP contains clear instructions on establishing inherency. “In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” MPEP § 2112 (quoting *Ex parte Levy*, 17 USPQ2d 1451, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original)) (internal quotations omitted). “The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic.” MPEP § 2112 (citing *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993)) (emphasis in original). “Also, ‘[a]n invitation to investigate is not an inherent disclosure’ where a prior art reference ‘discloses no more than a broad genus of potential applications or its discoveries.’” MPEP § 2112 (quoting *Metabolife Labs., Inc. v. Lab. Corp. of Am. Holdings*, 370 F.3d 1354, 1367 (Fed. Cir. 2004)). “‘A prior art reference that discloses a genus still does not inherently disclose all species within that broad category’ but must be examined to see if a disclosure of the claimed species has been made or whether the prior art reference merely invites further experimentation to find the species.” MPEP § 2112 (quoting *Metabolife Labs., Inc.*, 370 F.3d at 1367).

Since a folding device is not necessary in order to fold the paper stack PSS after it is cut by the cutting apparatus 17, Examiner has failed to properly establish that Honegger inherently discloses a folding device, as stated in Claim 41.

Accordingly, Applicant respectfully asserts that Examiner has failed to establish a *prima facie* case of obviousness of independent Claim 41, and corresponding Claims 42-43 and 45 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-43 and 45 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,961,758 to Honegger.

III. REJECTION OF CLAIMS 41-46 UNDER 35 U.S.C. § 102(B) BASED ON DEANGELIS

On page 4 of the current Office Action, the Examiner rejects Claims 41-46 under 35 U.S.C. § 102(b) as being anticipated by DeAngelis. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Amended Claim 41 states, in part:

“a joining device for joining a cover **sheet** to at least one contents **sheet**;

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

As an initial matter, Applicant notes that Claim 41 has been amended to specify that the folding device passes through the guide planes. This further clarifies what is meant by “the two guide planes being provided in the vicinity of the folding device”. Applicant respectfully asserts that DeAngelis fails to disclose this language of Claim 41.

Examiner asserts that DeAngelis discloses the remaining language of Claim 41 above. This, however, misinterprets the teachings of DeAngelis.

First, similar to Honegger, DeAngelis teaches to web rolls NP1 to NP3, and not to sheets as stated in Claim 41. See DeAngelis, Col. 4, Lns. 31-36, Figs. 1 and 3. While the web rolls NP1 to NP3 are eventually cut so as to create sheets, this is not until after portions of the web rolls NP1 to NP3 are joined. DeAngelis, Col. 6, Ln. 50 – Col. 7, Ln. 17, Figs. 1 and 3. As such, DeAngelis fails to disclose a joining device for joining a cover sheet to at least one contents sheet, as stated in Claim 41. Similarly, DeAngelis also fails to disclose separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively, as stated in Claim 41.

Second, DeAngelis teaches that, after an adhesive or paste is applied to the webs NP1 to NP3, the webs NP1 to NP3 are then joined by the former roller 54 and the pressure roller 56. DeAngelis, Col. 6, Lns. 50-61, Fig. 1. Only after the webs NP1 to NP3 are joined, are the webs NP1 to NP3 are then folded by the former nose and the nipping rollers 62. DeAngelis, Col. 6, Ln. 65 – Col. 7, Ln. 1, Fig. 1. As such, it is clear that the folding device (i.e., the former nose and the nipping rollers 62) of DeAngelis is separate from the joining device (i.e., the former roller 54 and the pressure roller 56). Thus, DeAngelis fails to disclose a folding device being simultaneously a joining device so that the sheets can be joined during folding, as stated in Claim 41.

Accordingly, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of obviousness of independent Claim 41, and corresponding Claims 42-46 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-46 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,749,567 to DeAngelis.

IV. REJECTION OF CLAIMS 41-43, 46, AND 47 UNDER 35 U.S.C. § 102(B) BASED ON OSAKO

On page 5 of the current Office Action, the Examiner rejects Claims 41-43, 46, and 47 under 35 U.S.C. § 102(b) as being anticipated by Osako. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Amended Claim 41 states, in part:

“two guide planes, including a first guide plane and a second guide plane, lying one above the other at a distance from one another and in a parallel orientation to each other, the two guide planes being provided in the vicinity of the folding device, **so that the folding device passes through the guide planes**, for separate placement of the contents sheet and cover sheet in the first guide plane and the second guide plane, respectively; and

“said folding device being **simultaneously** a joining device so that the sheets can be joined during folding.” (emphasis added).

As an initial matter, Applicant notes that Claim 41 has been amended to specify that the folding device passes through the guide planes. This further clarifies what is meant by “the two guide planes being provided in the vicinity of the folding device”. Applicant respectfully asserts that Osako fails to disclose this language of Claim 41.

Examiner asserts that Osako discloses the remaining language of Claim 41 above. This, however, misinterprets the teachings of Osako.

First, Osako fails to disclose any plane guides. Osako teaches delivering pre-folded sheets in the form of body signatures 301 to the conveying chain mechanisms 111 and 117. See Osako, Col 9, Lns. 10, 26, Fig. 8. As such, since they convey via a chain, the conveying chain mechanisms 111 and 117 convey the body signatures 301 via a line, and not a plane. In addition, a plane is a two-dimensional space, and only a two-dimensional space. However, the body signatures 301 are in the form of folded sheets. While a flat sheet can be conveyed along a two dimensional space, a folded sheet is not flat. Rather, a folded sheet, unlike a flat sheet, is located in a three-dimensional space. As such, it is physically impossible to convey a folded sheet along a plane. Thus, Osako fails to disclose plane guides, as stated in Claim 41.

Second, Osako fails to disclose a folding device being simultaneously a joining device. As stated above, Osako teaches delivering pre-folded sheets in the form of body signatures 301 to the conveying chain mechanisms 111 and 117. See Osako, Fig. 8. As such, the body signatures 301 are already folded before they are joined. As such, any folding device (which, it should be noted, Osako fails to actually disclose) would have to be located before the body signature feeders 119. As such, any folding device would be completely removed and separate from the pressure rollers 125 and 128. As such, Osako fails to disclose folding device being simultaneously a joining device so that the sheets can be joined during folding, as stated in Claim 41.

While Examiner asserts that the pressure rollers 125 and 128 disclose a folding device, there is no basis whatsoever in Osako for such an assertion. It is clear from Fig. 8 that the body signatures 301 are already folded before they even contact the conveying chain

mechanisms 111 and 117. The pressure rollers 125 and 128 of Osaka do not further fold the body signatures 301. Rather, they merely press the back of the body signatures 301 so as to promote bonding. Osaka, Col 10, Lns. 9-15 and 27-29. As such, the pressure rollers 125 and 128 of Osaka are not a folding mechanism, as stated in Claim 41.

Furthermore, Osaka actually fails to disclose a folding mechanism whatsoever. As discussed above, the body signatures 301 are already folded before they ever enter the device of Osaka. See Osaka, Figs. 1-9. Osaka contains no discussion whatsoever as to how the body signatures 301 are folded. As such, Osaka fails to disclose a folding device, as stated in Claim 41.

In addition, as discussed above in relation to Honegger, a folding device is not necessary in order to fold the body signatures 301. As such, Osaka fails to inherently discloses a folding device, as stated in Claim 41.

Accordingly, Applicant respectfully asserts that Examiner has failed to establish a prima facie case of obviousness of independent Claim 41, and corresponding Claims 42, 43, 46, and 47 because they are dependant from independent Claim 41. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 41-43, 46, and 47 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 5,678,813 to Osako et al.

V. REJECTION OF CLAIM 48 UNDER 35 U.S.C. § 103(A) BASED ON OSAKO IN VIEW OF GRAUSHAR

On page 6 of the current Office Action, the Examiner rejects Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over Osako in view of Graushar. This rejection is respectfully traversed and believed overcome in view of the following discussion.

Claim 48 depends from independent Claim 41. As Claim 41 is allowable, so must be Claim 48. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of

Claim 48 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,678,813 to Osako et al. in view of U.S. Patent No. 5,662,448 to Graushar et al.

VI. REJECTION OF CLAIMS 49 AND 50 UNDER 35 U.S.C. § 103(A) BASED ON OSAKO IN VIEW OF MIASKOFF

On page 7 of the current Office Action, the Examiner rejects Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over Osako in view of Miaskoff. These rejections are respectfully traversed and believed overcome in view of the following discussion.

Claims 49 and 50 depend from independent Claim 41. As Claim 41 is allowable, so must be Claims 49 and 50. Therefore, Applicant respectfully requests that Examiner withdraw the rejection of Claims 49 and 50 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,678,813 to Osako et al. in view of U.S. Patent No. 3,816,866 to Miaskoff et al.

Based upon the above remarks, Applicant respectfully requests reconsideration of this application and its early allowance. Should the Examiner feel that a telephone conference with Applicant's attorney would expedite the prosecution of this application, the Examiner is urged to contact him at the number indicated below.

Respectfully submitted,

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